

ESTTA Tracking number: **ESTTA368532**

Filing date: **09/15/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Don Durban
Granted to Date of previous extension	09/15/2010
Address	2120 Jimmy Durante Blvd. Suite 108 Del Mar, CA 92014 UNITED STATES
Party who filed Extension of time to oppose	DonDurban
Relationship to party who filed Extension of time to oppose	Space error

Attorney information	Valerie Ann Nemeth Attorney at Law 191 Calle Magdalena, Suite 270 Encinitas, CA 92024 UNITED STATES VANemeth@cs.com Phone:760-944-4130
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Applicant Information

Application No	77765262	Publication date	05/18/2010
Opposition Filing Date	09/15/2010	Opposition Period Ends	09/15/2010
Applicant	Cloudco, Inc. One American Road Cleveland, OH 44144 UNITED STATES		

Goods/Services Affected by Opposition


Class 041.


All goods and services in the class are opposed, namely: Entertainment services in the nature of on-going television programs in the field of children's entertainment

Grounds for Opposition


False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2062821	Application Date	01/22/1996
Registration Date	05/20/1997	Foreign Priority Date	NONE
Word Mark	PLANET X		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1995/02/01 First Use In Commerce: 1995/02/01 entertainment, namely a continuing sports show distributed over television, satellite, audio, and video media		

U.S. Registration No.	2597101	Application Date	09/11/2000
Registration Date	07/23/2002	Foreign Priority Date	NONE
Word Mark	PLANET XYZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/11/00 First Use In Commerce: 1999/11/00 EDUCATION AND ENTERTAINMENT SERVICES, NAMELY, CREATION, DEVELOPMENT, PRODUCTION AND DISTRIBUTION OF SPORTS, MUSIC, CULTURAL AND YOUTH-ORIENTED AUDIO AND VISUAL PROGRAMMING THROUGH LIVE AND PRERECORDED MEDIA, NAMELY, AUDIO AND VIDEO TAPES; TELEVISION VIA DIRECT SATELLITE FEED, BROADCAST, CABLE AND INTERNET; AND FILM FESTIVALS AND EXHIBITIONS		

U.S. Registration No.	3073450	Application Date	04/04/2005
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Registration Date	03/28/2006	Foreign Priority Date	NONE
Word Mark	PLANET X		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1995/06/00 First Use In Commerce: 1995/08/00 Specialty program broadcasting services over television and via the Internet		

Attachments	75046744#TMSN.gif (1 page)(bytes) 76124958#TMSN.gif (1 page)(bytes) 78601223#TMSN.jpeg (1 page)(bytes) Planet X Packages Opposition.pdf (4 pages)(159054 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ss/
Name	Valerie Ann Nemeth
Date	09/15/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 77765262
For the Mark PACKAGES FROM PLANET X
Published in the Official Gazette on May 18, 2010

DON DURBAN]	
]	
Opposer,]	
]	
vs.]	
]	Opposition No. _____
]	
CLOUDCO, INC.]	
]	
Applicant.]	
_____]	

NOTICE OF OPPOSITION

Opposer, Don Durban, an individual residing in Encinitas, California, believes he will be damaged by the registration of the term “PACKAGES FROM PLANET X”, as set forth in Serial No. 77765252 filed by Applicant Cloudco, Inc., and by his attorney of record hereby opposes the same.

Applicant is seeking registration on the Principal Register of the term “PACKAGES FROM PLANET X” for “Entertainment services in the nature of on-going television programs in the field of children’s entertainment” in International Class 041, which is hereby as further set forth below. The opposed mark was published for opposition on May 18, 2010 and Opposer has properly obtained extensions of time within which to file this Notice of Opposition.

As ground for Opposition, it is hereby alleged as follows:

1. Opposer is the registered owner of the mark “PLANET X” and design, Registration No. 2062821 in International Class 041, for "PLANET X", Registration No. 3073450 in International Class 038, and "PLANET XYZ" and design, Registration No. 2597101 in International Class 041, and has been continuously using the marks in commerce since 1995 and 1999 respectively in the related fields of

entertainment as producer, distributor and broadcaster of continuing sports oriented shows distributed via over television, satellite, cable, the internet, audio and video media, and featuring events in the fields of surfing, skateboarding, snowboarding, mountain biking, and other outdoor sports and for all markets and demographics. Opposer's registrations are current and in good standing and, Nos. 2062821 and 2597101 have become incontestable.

2. Opposer has been engaged in the entertainment fields as described, has been advertising, promoting and marketing the mark "PLANET X" and "PLANET XYZ" in such fields over a variety of medium, and including onsite specialty events to promote the same. Opposer has expended substantial time and expense in the promotion and use of Opposer's mark and has as a result achieved significant goodwill and recognition in the entertainment industry, sporting events and related fields, both nationally and internationally.

3. Opposer has further used the mark in connection with its goods and services in commerce in the sponsorship, promotion and public service campaigns of and for special events, inclusive of youth organizations and centers, both for profit and nonprofit, such as Boys and Girls Clubs, YMCA's, church youth groups, and teen entertainment centers, and has done so continuously since Opposer's first use in commerce. Such promotions include the prominent display of Opposer's marks on clothing, sporting goods and equipment, printed materials including brochures, posters, newspaper and magazine advertisements, subscription services, audio and visual devices such as compact discs and DVDs, and in partnership and co-sponsorship with other companies and ventures in similar fields

4. Notwithstanding Opposer's extended and long term prior rights in and to its service mark, Applicant Cloudco, Inc. has applied to register the mark "PACKAGES FROM PLANET X", as of June 22, 2009 as an Intent-to-Use application pursuant to Section 1(b), in the identical class of services, as more specifically set forth in the subject Application.

5. Opposer believes and avers that Applicant's use and registration of the term "PACKAGES FROM PLANET X", would damage and dilute Opposer's business and goodwill in Opposer's mark for the following reasons;

- a. Opposer believes and avers that Applicant's services are marketed to the same type and generation of consumers and purchasers as those of Opposer;
- b. Applicant's proposed mark incorporates Opposer's marks in their entireties and hence is confusingly similar to Opposer's marks;
- c. Applicant's proposed mark for entertainment related services, are virtually identical and/or in the same market as those services of Opposer.
- d. Registration of Applicant's mark would give the Applicant the unqualified right to pass off its services as that of Opposer;
- e. Applicant's published mark is so similar to Opposer's mark that it would be likely to cause confusion or to cause mistake in the minds of the public or to deceive consumers who, upon exposure to Applicant's marks "PLANET X" and "PLANET XYX", used in connection with Applicant's services, would believe that such term and such goods/services originated with, are connected to or associated with, or are sponsored or approved by Opposer;
- f. Applicant's use of the term "PACKAGES FROM PLANET X" is a wrongful appropriation of Opposer's valuable goodwill associated with its "PLANET X" and "PLANET XYZ" marks, and hence will cause confusion, loss of goodwill and loss of business to Opposer.
- g. Use by Applicant of the term "PACKAGES FROM PLANET X" for the services set forth in its application for registration is likely to dilute the goodwill obtained by Opposer's use in the market which it has enjoyed for over fifteen (15) years.

WHEREFORE, for all the foregoing reasons, Opposer, Don Durban, believes that he will be damaged by said registration and requests that the Opposition be sustained and registration refused.

Dated: September 15, 2010

Respectfully Submitted,
/Valerie Ann Nemeth/
Attorney for Opposer, Don Durban
191 Calle Magdalena, Suite 270
Tel: 760-944-4130 Fax: 760-944-3325
Email: VANemeth@cs.com

I hereby certify that this Notice of Opposition is being electronically filed with the Trademark Trial and Appeal Board through its website at <http://estta.uspto.gov> on September 15, 2010.

Dated: September 15, 2010

/Valerie Ann Nemeth/
Attorney for Opposer, Don Durban
191 Calle Magdalena, Suite 270
Encinitas, CA. 92024
Tel: 760-944-4130 Fax: 760-944-3325

This is to certify that a true and correct copy of the foregoing "Notice of Opposition" was mailed by United States First Class Mail, Postage Prepaid, to Stephen L. Scharf, Cloudco, Inc., 1 American Road, Cleveland, OH 44144-2301 on this 15th day of September, 2010.

/Valerie Ann Nemeth/

Valerie Ann Nemeth